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26652	7590	09/22/2005	EXAMINER	
AT&T CORP. P.O. BOX 4110 MIDDLETOWN, NJ 07748			PRENDERGAST, ROBERTA D	
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			2671	

DATE MAILED: 09/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/003,092

Applicant(s)

OSTERMANN ET AL.

Examiner

Roberta Prendergast

Art Unit

2671

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 16-19, 25, 26 and 29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15, 20-24, 27, 28 and 30-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 May 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/23/2005
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Specification

The amended title, "Apparatus And Method Of Customizing Animated Entities For Use In A Multi-Media Communication Application", is acceptable. Examiner further acknowledges the inclusion of the serial numbers for the related applications. Examiner withdraws the objection to the Title of the Invention and the objection to the disclosure.

Drawings

The drawings were received on 5/24/2005. These drawings are acceptable.

Section 112 Rejections of Claims 11 and 13

Examiner acknowledges that amended claims 11 and 13 no longer have the insufficient antecedent basis problem and therefore the 112 rejections to claims 11 and 13 is withdrawn.

Terminal Disclaimer

The terminal disclaimers filed on 5/24/2005 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of 10/003092 has been reviewed and is NOT accepted.

The application/patent being disclaimed has been improperly identified since the number used to identify the application being disclaimed is incorrect. The correct number is 10/003092.

Examiner attempted to contact Applicant by phone on 9/13/2005 no return call has been received prior to the submission of this action. Applicant transposed serial number of application being disclaimed with the subject application number. Although it is clear that the numbers were transposed, the transposition of the serial numbers had

Art Unit: 2671

the opposite effect of disclaiming the subject application with respect to the pending applications. Applicant needs to submit corrected terminal disclaimers; a second disclaimer fee will not be required. The Double Patenting rejections with regards to the pending applications will be withdrawn upon receipt of the corrected terminal disclaimers.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 16-19, 25-26, and 29 are cancelled, thus the double patenting rejections with regards to these claims are hereby withdrawn.

Claims 1 and 4 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 9 of copending Application No. 10001120 in view of Ming Ouhyoung et al., "Web-enabled Speech Driven Facial Animation", Proc. Of ICAT '99 (int'l Conference on Artificial Reality and Tele-existence), pp 23-28, Dec 1999, Tokyo, Japan, Sato et al. U. S. Patent No. 5537662, and Mayle et al. U.S. Patent No. 6018774.

Referring to claim 1, copending Application No. 10001120 teaches receiving from the sender an image file to a server (claim 9, line 4), presenting to the sender the image file and requesting the sender to mark features on the image file (claim 9, lines 5-6), presenting to the sender a preview of at least one expression associated with the marked image file (claim 9, lines 7-8), and if the sender accepts the image file after the preview, presenting again the image file as an optional animated entity when the sender chooses an animated entity to deliver a multi-media message (claim 9, lines 9-10), but does not teach wherein the image file has sender-assigned name, gender, category, and indexing information, wherein the category information relates to whether the animated entity will be generally available or only available for the sender, a choice of a generic face model from a plurality of generic face model templates, presenting both the image file and generic face template to the sender and requesting the sender to mark features on the image file, and if the sender does not accept the image file after the preview, presenting again the image file and selected model template for the sender to redo or add marked features on the image file. Copending claim 9 further includes an image file having a background as well as an entity wherein the animated entity being presented includes the image file background. It would be obvious to one having ordinary skill in the art at the time the invention was made to remove an element or step if the remaining elements or steps operate in the same manner.

Ming Ouhyoung et al. discloses presenting to the sender both the image file and a generic face model template wherein the sender is instructed to mark the image file

Art Unit: 2671

(figures 3 and 4; Section 2.1 Head model fitting, page 24; Section 3.1 Expression editor, page 25).

Sato et al. teaches wherein the image file has sender-assigned name (figures 34(A-C)), gender (figures 14 and 25), category (figures 9, 11-13, and 15), and indexing information (figures 21, 23, 26 and 27; column 11-12, lines 63-8, the use of a register key and part pattern numbers is indexing information), presenting to the sender a choice of a generic face model template (figures 2, 4, 6, and 8), and further teaches wherein, if the sender does not accept the image file after the preview, presenting again the image file for the sender to redo or add marked features.

Mayle et al. teaches wherein the image file is made generally available to recipients of the multi-media message for a limited time period at which point the image files will be available only to the sender (figure 2; column 5, lines 53-61; column 7, lines 7-20).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of delivering a multi-media message from a sender to a receiver to include wherein the image file has sender-assigned name, gender, indexing, and category information, wherein the category information relates to whether the animated entity will be generally available or only available to the sender, presenting to the sender a choice of a generic face model template from a plurality of face model templates, presenting to the sender both the image file and a generic face model template, and the option to redo or add marked features if the sender does not accept the image file after the preview because the

motivation for modifying the method to include the use of category information because the use of category information to determine whether the animated entity will be generally available or only available to the sender by saving an animated entity in a private or public database to prevent a personalized animated entity from being used by the public while allowing the storage of more generic animated entities in a public database, thereby saving memory space, the use of a sender-assigned gender further allows the server to present a choice of generic templates with specific characteristics in order to reduce the possibly large number of generic face model templates being presented to the sender, the use of sender-assigned name and indexing information permits retrieval of the animated entities when stored in a searchable database and permits the display of personal information as well, presenting to the sender a choice of a generic face model template from a plurality of face model templates to allow the sender to select a unique face model template which more closely matches the image file and moves in response to reproduced sounds in a simple operation (Sato et al., column 2, lines 56-60), presenting to the sender both the image file and a generic face model template to allow the sender to edit the expression on the generic face template by dragging feature points on the face image file, and the option to redo or add marked features to the image file if the sender does not accept the image file after the preview allows for the correction of mistakes or the further enhancement of the image file.

Referring to claim 4, the rationale for claim 1 above is incorporated herein, copending Application No. 10001120, as modified above, teaches the method of creating an animated entity comprising presenting the image file and the selected

generic face model template to the sender and requesting the sender to mark points on the image file but does not teach wherein requesting the sender to mark features on the image file further comprises instructing the sender to mark points on the image file by indicating a corresponding point on the selected model template.

Ming Ouhyoung et al. discloses instructing the sender to mark feature points on the image file by indicating a corresponding point on the selected model template (figures 3 and 4; Section 2.1 Head model fitting, page 24; Section 3.1 Expression editor, page 25).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of creating an animated entity to include instructing the sender to mark points on the image file by indicating a corresponding point on the selected model template because modifying the method of creating an animated entity for delivering a multi-media message from a sender to a receiver to include instructing the sender to mark feature points on the image file by indicating a corresponding point on the selected model template thereby allowing the adjustment of the feature points of the generic facial template to the proper position during editing of the expressions.

This is a provisional obviousness-type double patenting rejection.

Claims 5, 6, 12 and 13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 9 of copending Application No. 10001120 in view of Ming Ouhyoung et al., "Web-enabled

Art Unit: 2671

Speech Driven Facial Animation", Proc. Of ICAT '99 (int' Conference on Artificial Reality and Tele-existence), pp 23-28, Dec 1999, Tokyo, Japan and Sato et al. U. S. Patent No. 5537662, as applied to claims 1 and 4 above, and further in view of H. Noot and Zs.M. Ruttkay, "CharToon 2.0 Manual", Information Systems (INS), INS-R0004 January 31, 2000.

Referring to claim 5, the rationale for claim 4 above is incorporated herein, copending Application No. 10001120, as modified above, teaches a method of creating an animated entity for delivering a multi-media message comprising presenting the image file and the selected model template to the sender and instructing the sender to mark points on the image file by indicating a corresponding point on the generic face model template but does not teach wherein the corresponding points on the generic face model template are indicated by highlighting and further does not teach instructing the sender to mark points until a threshold number of points on the image file have been marked.

H. Noot et al. teaches wherein points on a generic face model template are highlighted (H. Noot et al. Section 3.7.1 Elements of components, page 22, paragraphs 2, 3, and 4, points on the generic template are color coded).

Ming Ouhyoung et al. discloses instructing the sender to mark points until a threshold number of points on the image file has been marked by the sender (Section 2.1 Head model fitting, page 24).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of creating an animated entity for

delivering a multi-media message to include the use of highlighting to indicate a corresponding point on the generic face model template in order to visibly indicate a point to be marked on the image file to ensure accurate placement of feature points and to include instructing the sender to mark feature points on the image file by indicating a corresponding point on the selected model template until a minimal number of points on the image file have been marked to allow emotional expressions and to model speech.

Referring to claim 6, the rationale for claim 5 above is incorporated herein, copending Application No. 10001120, as modified above, teaches a method of creating an animated entity for delivering a multi-media message comprising instructing the sender to mark points on the image file corresponding to highlighted points on the selected model template until a threshold number of points on the image file have been marked by the sender but does not teach presenting the sender an option to mark additional points wherein if the sender chooses to mark additional points, presenting the image file and the selected model template to the sender and instructing the sender to mark additional points on the image file corresponding to highlighted points on the selected model template until a maximum number of points on the image file have been marked by the sender.

H. Noot et al. teaches presenting the sender an option to mark additional points (Section 3.8. Component editing, page 29, figure 11 and paragraphs 3 and 5; page 30, paragraph 3; page 32, paragraphs 2 and 3), if the sender chooses to mark additional points, presenting the image file to the sender and instructing the sender to mark additional points on the image file until a maximum number of points on the image file

have been marked by the sender (H. Noot et al., Section 3.7.6 User Defined Composite components, page 32, InsertControlPoints and InsertFixedPoints, it can be assumed that when the sender decides not to insert/mark additional points that a maximum number of points has been reached) and if the sender chooses not to mark additional points, continuing presenting a preview of the image file (see rationale for claim 1 for previewing image file).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of creating an animated entity for delivering a multi-media message to include presenting to the sender an option to mark additional points for enhancing the visual portrayal of emotion and speech wherein, if the sender chooses to mark additional points, presenting the image file to the sender and instructing the sender to mark additional points on the image file in order to realistically portray complex emotion and speech in animated entities and to further include instructing a sender to mark additional points until a maximum number of points on the image file has been marked to reduce processing time.

Referring to claim 12, the elements in claims 1, 4 and 5 above are recited in claim 12, therefore the same rejections apply, copending Application No. 10001120, as modified above, teaches a method of creating an animated entity for delivering a multi-media message comprising instructing the sender to mark points on the image file by indicating highlighted corresponding points on the selected model template but does not specifically teach requesting the sender to mark features on the image file associated with features on the selected model template highlighted in succession.

H. Noot et al. teaches wherein features on the selected model template are highlighted in succession (Section 3.6.2 Global drawing options, page 17, DrawOptions/ShowSelection_TestControl; Section 3.6.5 Intermezzo: component selection, page 19).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of creating an animated entity for delivering a multi-media message to include requesting the sender to mark features on the image file associated with features on the selected model template highlighted in succession to allow the sender to accurately mark features on the image file in order to reduce the amount of processing time required to correct feature marking errors and to allow the marking of features that may be too close to each other.

Referring to claim 13, the elements for claims 1 and 12 are found in claim 13, therefore the same rejections apply. It would further be obvious to one having ordinary skill in the art at the time the invention was made to remove an element or step (i.e. claim 1, elements associated with the generic facial model template) if the remaining elements or steps operate in the same manner.

This is a provisional obviousness-type double patenting rejection.

Claims 10, 11 and 15 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 16-18 of copending Application No. 10003350.

Although the conflicting claims are not identical, they are not patentably distinct from each other because presenting the sender with the option to choose aging effects associated with the animated entity and modifying the image file to increase or decrease the appearance of age of the image file according to the option chosen by the sender as in claim 10, presenting the sender with the option to modify the appearance of the weight of the animated entity according to the option chosen by the sender as in claim 11, and presenting the sender with options to modify a parameter associated with the appearance of weight for the image file as in claim 15 are all found in the copending application in claims 16-18. Copending claims 16-18 further disclose presenting the sender with options to modify a parameter associated with an eye color feature and a mouth protrusion feature, it would be obvious to one having ordinary skill in the art at the time the invention was made to remove an element or step if the remaining elements or steps operate in the same manner.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 20 and 21 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 9 of copending Application No. 10001120 in view of Mayle et al. U. S. Patent No. 6018774.

Referring to claim 20, copending Application No. 10001120 teaches a method of enabling sender customization of an animated entity for use in delivering a multi-media message over a network comprising receiving from the sender an image of an entity to

Art Unit: 2671

be used as the animated entity (claim 9, line 4), requesting the sender to mark a plurality of facial features on the entity and receiving facial features marked by the sender (claim 9, lines 5-8) and computing a customized model associated with the entity (claim 9, lines 9-10) but does not teach storing the customized model in a private database for restricted access by the sender. Although, '1120 further teaches wherein the sender-selectable personal animated entity includes the image file background, it is obvious to remove an element or step if the remaining elements or steps operate in the same manner.

Mayle et al. teaches receiving from the sender, over a network (figures 1-3; column 4, lines 9-11, 20-32, and 51-67), an image of an entity to be used as the animated entity (column 5, lines 1-1; column 7, lines 7-20; column 10, lines 35-45, i.e. it is understood that an image saved as a .gif file can be used as the animated entity) and storing the customized model in a private database for restricted access by the sender (column 5, lines 19-31, 40-67 and column 6, lines 1-3, i.e. it is understood that the sender can restrict access to the image in the database to themselves only).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of enabling sender customization of an animated entity for use in delivering a multi-media message to include storing the customized model in a private database for restricted access by the sender because modifying the method to include storing the customized model in a private database for restricted access by the sender would prevent the unauthorized use of personalized animated entities (column 2, lines 48-63).

Referring to claim 21, the rationale for claim 20 above is incorporated herein, copending Application No. 10001120, as modified above, teaches a method of creating an animated entity for delivering a multi-media message further comprising after computing the customized model associated with the entity, displaying at least one facial expression to the sender of the customized model (claim 9, lines 7-8).

This is a provisional obviousness-type double patenting rejection.

Claims 22-24 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 9 of copending Application No. 10001120 in view of Mayle et al. U. S. Patent No. 6018774 as applied to claim 21 above and further in view of H. Noot and Zs.M. Ruttkay, "CharToon 2.0 Manual", Information Systems (INS), INS-R0004 January 31, 2000.

Referring to claim 22, the rationale for claim 21 above is incorporated herein, copending Application No. 10001120, as modified above, teaches a method of creating an animated entity for delivering a multi-media message comprising after computing the customized model associated with the entity, displaying at least one facial expression to the sender of the customized model but does not teach after displaying at least one facial expression to the sender of the customized model, presenting the sender with an option to change a magnitude associated with each displayed facial expression.

H. Noot et al. teaches after displaying at least one facial expression to the sender of the customized model, presenting the sender with an option to change a magnitude associated with each displayed facial expression (Section 4.1. Using Face Player, page

35, paragraph 3; Section 5.1. Principle and usage of the Emotion Disc, pages 37-38; Section 7.4. Emotion Disc, page 55; Section 1.7. .dsc disc file, page 64; Plate 4, page 68).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of enabling sender customization of an animated entity for use in delivering a multi-media message to include after displaying at least one facial expression to the sender of the customized model, presenting the sender with an option to change a magnitude associated with each displayed facial expression to increase or decrease the intensity of the emotion being expressed.

Referring to claim 23, the rationale for claim 20 above is incorporated herein, copending Application No. 10001120, as modified above, teaches a method of creating an animated entity for delivering a multi-media message comprising requesting the sender to mark a plurality of facial features on the entity but does not specifically teach wherein requesting the sender to mark a plurality of facial features on the entity further comprises requesting the sender to mark facial features associated with eye corners, eyelids, nose, mouth corners, lip boundaries, and hair outline.

H. Noot et al., teaches wherein requesting the sender to mark a plurality of facial features on the entity further comprises requesting the sender to mark facial features associated with eye corners, eyelids, nose, mouth corners, lip boundaries, and hair outline (Section 3.6.6 Operations on components, page 20, figure 4; Section 3.7.2

Types of components, pages 23-25; Section 3. Appendix: Color Plates, pages 67-68, Plates 2.a, 2.b, 3.a and 3.b).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of enabling sender customization of an animated entity for use in delivering a multi-media message to include wherein requesting the sender to mark a plurality of facial features on the entity further comprises requesting the sender to mark facial features associated with eye corners, eyelids, nose, mouth corners, lip boundaries, and hair outline because marking facial features associated with eye corners, eyelids, nose, mouth corners, lip boundaries, and hair outline allows for the realistic portrayal of emotion and speech during animation of an animated entity.

Referring to claim 24, it recites the elements found in claim 20 therefore the same rejections to those elements apply, copending Application No. 10001120, as modified above, teaches a method of enabling sender customization of an animated entity for use in delivering a multi-media message but does not teach presenting a proof-animated entity to the sender based on the customized model.

H. Noot et al. teaches presenting a proof-animated entity to the sender based on the customized model (Section 4.2.1 Integrated mode and 4.2.2 Starting Face Player from Animation Editor, page 35).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of enabling sender customization of an animated entity for use in delivering a multi-media message to include presenting

Art Unit: 2671

a proof-animated entity to the sender based on the customized model to allow the sender to visually test how the delivery of the multi-media message by the animated entity will appear.

This is a provisional obviousness-type double patenting rejection.

Claims 27, 28, and 30-32 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 8-10 of copending Application No. 10001120 in view of H. Noot and Zs.M. Ruttkay, "CharToon 2.0 Manual", Information Systems (INS), INS-R0004 January 31, 2000.

Referring to claim 27, copending Application No. 10001120 teaches a method of creating an animated entity for delivering a multi-media message from a sender to a receiver comprising receiving from the sender an image file, requesting the sender to mark features on the image file in preparation for creating an animated entity, and presenting the image file as an optional animated entity when the sender chooses an animated entity to deliver a multi-media message, see claims 1 and 8-10, but does not teach presenting the sender an option to zoom the image file wherein, if the sender selects to zoom the file, presenting the sender with a zoomed image file and requesting the sender mark features on the image file.

H. Noot et al. teaches presenting the sender an option to zoom the image file wherein, if the sender selects to zoom the file, presenting the sender with a zoomed image file, and requesting the sender to mark features on the image file in preparation for creating an animated entity (Section 3.1. The principle of creating faces with face

Art Unit: 2671

editor, page 10 figure 2 and page 11, paragraph 1; Section 3.6.2 Global drawing options, page 16, paragraphs 3-7; Section 6.2.3 Using the animation parameter staves, page 42, paragraph 6; Section 6.2.4 Creating a new animation, page 42-43; Section 6.4.1 Views and zooming, pages 44-45; Section 6.5 Editing an animation, page 46).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of enabling a sender to create a multi-media message to a recipient to include presenting the sender an option to zoom the image file wherein, if the sender selects to zoom the file, presenting the sender with a zoomed image file, and requesting the sender to mark features on the image file in preparation for creating an animated entity because the use of zooming an image to ensure accurate placement of the feature points in an image file for refined editing (Section 6.2.3 Using the animation parameter staves, page 42, paragraph 6; Section 6.2.4 Creating a new animation, page 42-43; Section 6.5 Editing an animation, page 46) is well known in the art.

Referring to claim 28, the rationale for claim 27 above is incorporated herein, copending Application No. 10001120 teaches a method of creating an animated entity for delivering a multi-media message from a sender to a receiver comprising receiving from the sender an image file wherein the image file has an entity and a background (claims 1 and 8-10) and presenting the image file as an optional animated entity further comprises presenting the sender with an option to include a background associated with the received image file (claim 10) but does not teach wherein presenting the image file

as an optional animated entity comprises presenting the sender with the following background choices for the selected animated entity:

- (1) a predefined background, wherein the animated entity is automatically scaled to fill a frame of a window in which it is presented;
- (2) a background associated with the received image file, wherein the animated entity has a same size as in the image file; and
- (3) if the sender selects to zoom the image file, the zoomed image file includes the background, wherein the animated entity is presented with a size as given in the zoomed image file.

H. Noot et al. teaches a method of creating an animated entity for delivering a multi-media message from a sender to a recipient and further discloses wherein presenting the image file as an optional animated entity comprises presenting the sender with the following background choices for the selected animated entity:

- (1) a predefined background, wherein the animated entity is automatically scaled to fill a frame of a window in which it is presented (H. Noot et al. Section 3.1. The principle of creating faces with Face Editor, page 10, figure 2(row 2), and page 11, paragraph 1; Section 3.5. Components, drawing order and rank, page 13, figure 3 and final paragraph; page 70, plate 13; Section 3.6.3 Global drawing operations, page 18, paragraphs 6 and 7; Section 3.6.6 Operations on components, page 19, paragraph 5, and page 21, paragraphs 8-13; Section 3.7.3 Basic components, page 26-27, final paragraph; Section 3.8. Component editing, page 31, paragraph 7: DynamicScaleSpecs, page 32, paragraphs 7-10, and pages 33-34, final paragraph);

(2) a background associated with the received image file, wherein the animated entity has a same size as in the image file (Section 3.6.2 Global drawing options, page 16, paragraph 4, i.e. the size of the background image and the animated entity are unchanged from their original size); and

(3) if the sender selects to zoom the image file, the zoomed image file includes the background, wherein the animated entity is presented with a size as given in the zoomed image file (Section 3.6.2 Global drawing options, page 16, paragraph 7, i.e. if the face file is zoomed, the background scenery is zoomed as well).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of enabling a sender to create a multi-media message to a recipient to include wherein presenting the image file as an optional animated entity comprises presenting the sender with the following background choices for the selected animated entity:

(1) a predefined background, wherein the animated entity is automatically scaled to fill a frame of a window in which it is presented;

(2) a background associated with the received image file, wherein the animated entity has a same size as in the image file; and

(3) if the sender selects to zoom the image file, the zoomed image file includes the background, wherein the animated entity is presented with a size as given in the zoomed image file, because presenting the sender with background choices for the selected animated entity to enhance the appearance of the multi-media message for artistic and aesthetic reasons is well known in the art.

Referring to claim 30, it recites the elements in claim 27 and the element numbered (1) in claim 28 and therefore the same rejections apply.

Referring to claim 31, it recites the elements in claim 27 and the element numbered (2) in claim 28 and therefore the same rejections apply.

Referring to claim 32, it recites the elements in claim 27 and the element numbered (2) in claim 28 and therefore the same rejections apply.

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 20-24, 27, 28, and 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over H. Noot and Zs.M. Ruttkay, "CharToon 2.0 Manual", Information Systems (INS), INS-R0004 January 31, 2000 in view of Mayle et al. U. S. Patent No. 6018774.

Referring to claim 20, H. Noot et al. discloses a method of enabling sender customization of an animated entity for use in delivering a multi-media message, comprised of receiving from the sender an image of an entity to be used as the animated entity (section 1.1. Overview: page 4, paragraph 6: *Faces*; page 5, paragraph

6: *External Images*; Section 3.8. Component editing: page 29, Figure 11; page 32, paragraph 9, *Load Image*), requesting the sender to mark a plurality of facial features on the entity, and receiving the facial features marked by the sender (Section 3.8. Component editing, page 29, figure 11 and paragraphs 3 and 5; page 30, paragraph 3; page 32, paragraphs 2 and 3), computing a customized model associated with the entity (Section 1.1. The components and data files of CharToon, page 4, paragraph 1; Section 2.1. Integrated mode and Section 2.2. Arranging windows of components, page 8; Section 3.1. The principle of creating faces, pages 10-11), and saving the customized entity (Section 3.1. The principle of creating faces, page 11, paragraph 4; Section 3.6.1. Opening and saving faces, page 14, *File/Save* and *File/SaveAs*; page 15, *File/More/SaveJavaObject*, *File/More/SaveJavaObjectAs*, *File/More/SaveFaceScriptAs*, and *File/More/SaveProfileAs*), but does not disclose wherein the image received from the sender is received over a network or storing the customized model in a private database for restricted access by the sender.

Mayle et al. teaches receiving from the sender, over a network (figures 1-3; column 4, lines 9-11, 20-32, and 51-67, i.e. it is understood that the Internet is comprised of a network of computers), an image of an entity to be used as the animated entity (column 5, lines 1-1; column 7, lines 7-20; column 10, lines 35-45) and storing the customized model in a private database for restricted access by the sender (column 5, lines 19-31, 40-67 and column 6, lines 1-3).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of enabling sender customization

of an animated entity for use in delivering a multi-media message to include receiving from the sender, over a network, an image of an entity to be used as the animated entity and storing the customized model in a private database for restricted access by the sender because modifying the method to include receiving from the sender, over a network, an image of an entity to be used as the animated entity to allow a variety of processing steps to be performed by the server (Mayle et al., column 2, lines 1-25; columns 13-14, lines 47-9) and storing the customized model in a private database for restricted access by the sender to prevent the unauthorized use of personal images (Mayle et al., column 2, lines 48-63).

Referring to claims 21 and 22, the rationale for claim 20 above is incorporated herein, H. Noot et al., as modified above, teaches a method of enabling sender customization of an animated entity for use in delivering a multi-media message comprised of computing a customized model associated with the entity and further teaches displaying at least one facial expression to the sender of the customized model after computing a customized model associated with the entity (Section 5.1. Principle and usage of the Emotion Disc and Section 5.2. Running Emotion Disc, pages 37-38; page 68, Plate 4). H. Noot et al. Further teaches presenting the sender with an option to change a magnitude associated with each displayed facial expression (Section 4.1. Using Face Player, page 35, paragraph 3; Section 5.1. Principle and usage of the Emotion Disc, pages 37-38; Section 7.4. Emotion Disc, page 55; Section 1.7. .dsc disc file, page 64; Plate 4, page 68).

Referring to claim 23, the rationale for claim 20 above is incorporated herein, H. Noot et al., as modified above, teaches a method of enabling sender customization of an animated entity for use in delivering a multi-media message and further teaches wherein requesting the sender to mark a plurality of facial features on the entity comprises requesting the user to mark facial features associated with eye corners, eye lids, nose, mouth corners, lip boundaries, and hair outline (Section 3.6.6 Operations on components, page 20, figure 4; Section 3.7.2 Types of components, pages 23-25; Section 3. Appendix: Color Plates, pages 67-68 (Plates 2.a., 2.b., 3.a. and 3.b.)).

Referring to claim 24, the rationale for claim 20 above is incorporated herein, H. Noot et al., as modified above, teaches a method of enabling sender customization of an animated entity for use in delivering a multi-media message as claimed above and further teaches presenting a proof-animated entity to the sender based on the customized model (Section 4.2.1 Integrated mode and 4.2.2 Starting Face Player from Animation Editor, page 35).

Referring to claim 27, the rationale for claim 20 above is incorporated herein, H. Noot et al., as modified above, teaches a method of creating an animated entity for delivering a multi-media message from a remote sender to a receiver comprising receiving from the remote sender an image file, as claimed above, presenting the sender an option to zoom the image file (Section 3.1. The principle of creating faces with face editor, page 10 figure 2 and page 11, paragraph 1; Section 3.6.2 Global drawing options, page 16, paragraphs 3-7; Section 6.2.3 Using the animation parameter staves, page 42, paragraph 6; Section 6.2.4 Creating a new animation, page 42-43;

Section 6.4.1 Views and zooming, pages 44-45; Section 6.5 Editing an animation, page 46), presenting the sender with a zoomed image file (Section 3.1. The principle of creating faces with face editor, page 10 figure 2 and page 11, paragraph 1; Section 3.6.2 Global drawing options, page 16, paragraphs 3-7; Section 6.2.3 Using the animation parameter staves, page 42, paragraph 6; Section 6.2.4 Creating a new animation, page 42-43; Section 6.4.1 Views and zooming, pages 44-45; Section 6.5 Editing an animation, page 46), requesting the sender to mark features on the image file in preparation for creating an animated entity (Section 3.1. The principle of creating faces with face editor, page 10 figure 2 and page 11, paragraph 1; Section 3.6.2 Global drawing options, page 16, paragraphs 3-7; Section 6.2.3 Using the animation parameter staves, page 42, paragraph 6; Section 6.2.4 Creating a new animation, page 42-43; Section 6.4.1 Views and zooming, pages 44-45; Section 6.5 Editing an animation, page 46), and presenting the image file as an optional animated entity when the sender chooses an animated entity to deliver a multi-media message (Section 1.1. The components and data files of CharToon, page 5, paragraph 3; Section 4.1. Using Face Player, page 35; instructing face player to dump each frame as a .gif file allows an image of the entity to be provided as an option when sender is choosing an entity to deliver a multi-media message; Sections 4.2.1 Integrated mode and 4.2.2 Starting Face Player from Animation Editor, page 35; 5.2 Running Emotion Disc, page 38; 6.2.2 Seeing the animated face, page 41).

Referring to claim 28, the rationale for claim 27 above is incorporated herein, H. Noot et al., as modified above, teaches a method of creating an animated entity for

Art Unit: 2671

delivering a multi-media message from a sender to a recipient and further discloses wherein presenting the image file as an optional animated entity comprises presenting the sender with the following background choices for the selected animated entity:

(1) a predefined background, wherein the animated entity is automatically scaled to fill the frame of the window in which it is presented (H. Noot et al. Section 3.1. The principle of creating faces with Face Editor, page 10, figure 2(row 2), and page 11, paragraph 1; Section 3.5. Components, drawing order and rank, page 13, figure 3 and final paragraph; page 70, plate 13; Section 3.6.3 Global drawing operations, page 18, paragraphs 6 and 7; Section 3.6.6 Operations on components, page 19, paragraph 5, and page 21, paragraphs 8-13; Section 3.7.3 Basic components, page 26-27, final paragraph; Section 3.8. Component editing, page 31, paragraph 7: DynamicScaleSpecs, page 32, paragraphs 7-10, and pages 33-34, final paragraph);

(2) a background associated with the received image file, wherein the animated entity has the same size as in the image file (Section 3.6.2 Global drawing options, page 16, paragraph 4, i.e. the size of the background image and the animated entity are unchanged from their original size); and

(3) if the sender selects to zoom the image file, the zoomed image file as the background, wherein the animated entity is presented with the size as given in the zoomed image file (Section 3.6.2 Global drawing options, page 16, paragraph 7, i.e. if the face file is zoomed, the background scenery is zoomed as well).

Referring to new claim 33, the rationale for claim 27 is incorporated herein, H. Noot et al., as modified above teaches a method for performing the steps of claim 27

Art Unit: 2671

and further teaches wherein multiple machines are used (page 41, Section 6.2.2 seeing the animated face, 2nd paragraph). It would have been obvious to one having ordinary skill in the art at the time the invention was made that a machine capable of performing the method described would necessarily comprise an apparatus with the means for performing the method.

Referring to claim 30, it recites the elements in claim 27 and the element numbered (1) in claim 28 and therefore the same rejections apply.

Referring to claim 31, it recites the elements in claim 27 and the element numbered (2) in claim 28 and therefore the same rejections apply.

Referring to claim 32, it recites the elements in claim 27 and the element numbered (2) in claim 28 and therefore the same rejections apply.

Claims 1, 2, 4-6, 12, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over H. Noot and Zs.M. Ruttkay, "CharToon 2.0 Manual", Information Systems (INS), INS-R0004 January 31, 2000 in view of Mayle et al. U. S. Patent No. 6018774 as applied to claims 20-24 above, and further in view of Ming Ouhyoung et al., "Web-enabled Speech Driven Facial Animation", Proc. Of ICAT '99 (int' Conference on Artificial Reality and Tele-existence), pp 23-28, Dec 1999, Tokyo, Japan.

Referring to claim 1, H. Noot et al. discloses a method of creating an animated entity for delivering a multi-media message from a sender to a recipient comprising receiving from a sender an image file to a server, sender-assigned name, gender, category, and indexing information, presenting to the sender a choice of a generic face

model template from a plurality of face model templates, requesting the sender to mark feature points on the image file, presenting the sender with a preview of at least one expression associated with the marked image file, determining whether the image is acceptable, the option to redo or add features if the displayed image is not acceptable, and presenting again the image file as an optional animated entity when the sender chooses an animated entity to deliver a multi-media message, see the rationale for claims 20-22 above which are incorporated herein, but does not teach presenting to the sender both the image file and a generic template wherein the sender is instructed to mark the image file and further does not teach wherein the category information relates to whether the animated entity will be generally available or only available to the sender.

Ming Ouhyoung et al. discloses presenting to the sender both the image file and a generic face model template wherein the sender is instructed to mark the image file (figures 3 and 4; Section 2.1 Head model fitting, page 24; Section 3.1 Expression editor, page 25).

Mayle et al. teaches wherein the image file is made generally available to recipients of the multi-media message for a limited time period at which point the image files will be available only to the sender (figure 2; column 5, lines 53-61; column 7, lines 7-20).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of creating an animated entity for delivering a multi-media message from a sender to a receiver to include presenting to the sender both the image file and a generic face model template because modifying

the method to include presenting to the sender both the image file and a generic face model template would allow the sender to edit the expression on the generic face template by dragging feature points on the face image file and to further modify the method to include wherein the category information relates to whether the animated entity will be generally available or only available to the sender because the use of category information to determine whether the animated entity will be generally available or only available to the sender by saving an animated entity in a private or public database to prevent a personalized animated entity from being used by the public while allowing the storage of more generic animated entities in a public database, thereby saving memory space.

Referring to claim 2, the rationale for claim 1 is incorporated herein, H. Noot et al, as modified above, teaches a method of creating an animated entity for delivering a multi-media message from a sender to a recipient and further teaches wherein the indexing information relates to enabling the animated entity to be in a searchable database (H. Noot et al. page 56, lines 19-28, i.e. it is understood that Profile Name and Face Name are the indexing information provided for the animated entity which is saved in a profile file and stored in a directory).

Referring to claim 4, the rationale for claim 1 above is incorporated herein, H. Noot et al, as modified above, teaches the method of claim 1 comprising creating an animated entity for delivering a multi-media message from a sender to a recipient and further teaches requesting the sender to mark features on the image file but does not teach wherein requesting the sender to mark features on the image file further

Art Unit: 2671

comprises instructing the sender to mark points on the image file by indicating a corresponding point on the selected model template.

Ming Ouhyoung et al. discloses instructing the sender to mark points on the image file by indicating a corresponding point on the selected model template (figures 2, 3 and 4; Section 2.1 Head model fitting, page 24; Section 3.1 Expression editor, page 25).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of creating an animated entity for delivering a multi-media message from a sender to a receiver to include instructing the sender to mark points on the image file by indicating a corresponding point on the selected model template because modifying the method of creating an animated entity for delivering a multi-media message from a sender to a receiver to include instructing the sender to mark points on the image file by indicating a corresponding point on the selected model template thereby allowing the adjustment of the points of the generic facial template to the proper position during editing of the expressions.

Referring to claim 5, the rationale for claim 4 above is incorporated herein, H. Noot et al, as modified above, teaches a method of creating an animated entity for delivering a multi-media message from a sender to a recipient comprising presenting the image file and the selected model template to the sender and instructing the sender to mark points on the image file corresponding to highlighted points on the selected model template (H. Noot et al. Section 3.7.1 Elements of components, page 22, paragraphs 2, 3, and 4, points on the generic template are color coded) but does not

specifically teach instructing sender to mark points until a threshold number of points on the image file have been marked by the sender.

Ming Ouhyoung et al. discloses instructing the sender to mark points until a threshold number of points on the image file has been marked by the sender (Section 2.1 Head model fitting, page 24).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of creating an animated entity for delivering a multi-media message from a sender to a receiver to include instructing the sender to mark feature points on the image file by indicating a corresponding point on the selected model template until a threshold number of points on the image file have been marked thereby allowing the sender to accurately model facial expressions while reducing the amount of processing time required for marking feature points.

Referring to claim 6, the rationale for claim 5 above is incorporated herein, H. Noot et al, as modified above, teaches a method of creating an animated entity for delivering a multi-media message from a sender to a recipient comprising instructing the sender to mark points on the image file corresponding to highlighted points on the selected model template until a threshold number of points on the image file have been marked by the sender and further teaches presenting the sender an option to mark additional points (Section 3.8. Component editing, page 29, figure 11 and paragraphs 3 and 5; page 30, paragraph 3; page 32, paragraphs 2 and 3), if the sender chooses to mark additional points, presenting the image file and the selected model template to the sender and instructing the sender to mark additional points on the image file

Art Unit: 2671

corresponding to highlighted points on the selected model template until a maximum number of points on the image file have been marked by the sender (H. Noot et al., Section 3.7.6 User Defined Composite components, page 32, InsertControlPoints and InsertFixedPoints, assumes a maximum number has been reached when the sender decides to stop marking feature points) and if the sender chooses not to mark additional points, continuing to the step of presenting a preview of the image file, (see rationale for claim 1 for previewing image file).

Referring to claim 12, H. Noot et al., as modified above, teaches a method of enabling a sender to create an animated entity for delivering a multi-media message from the sender to a recipient, the animated entity arranged to deliver a text message from the sender comprising of the steps as described in claims 1 and 5, which are incorporated herein.

Referring to claim 13, the rationale for claim 12 above is incorporated herein, H. Noot et al., as modified above, teaches a method of enabling a sender to create an animated entity for delivering a multi-media message from the sender to a recipient further comprised of the steps as described in claim 1, which is incorporated herein.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over H. Noot and Zs.M. Ruttkay, "CharToon 2.0 Manual", Information Systems (INS), INS-R0004 January 31, 2000 and Mayle et al. U. S. Patent No. 6018774 in view of Ming Ouhyoung et al., "Web-enabled Speech Driven Facial Animation", Proc. Of ICAT '99 (Int'l Conference on Artificial Reality and Tele-existence), pp 23-28, Dec 1999, Tokyo, Japan,

Art Unit: 2671

as applied to claim 1 above, and further in view of Grayson et al. U. S. Patent No. 5963217.

Referring to claim 3, the rationale for claim 1 above is incorporated herein, H. Noot et al., as modified above, teaches a method of creating an animated entity, as described above, but does not teach wherein gender information relates to a default gender of a voice associated with the animated entity.

Grayson et al. teaches wherein gender information relates to a default gender of a voice associated with the animated entity (column 8-9, lines 67-5 and column 9, lines 47-49).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method to include wherein gender information relates to a default gender of a voice associated with the animated entity because associating a female animated entity to a default female voice or a male animated entity to a default male voice can make messages more interesting and enhances communication (Grayson et al., column 10, lines 24-36).

Claims 7, 8 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over H. Noot and Zs.M. Ruttkay, "CharToon 2.0 Manual", Information Systems (INS), INS-R0004 January 31, 2000 and Mayle et al. U. S. Patent No. 6018774 in view of Ming Ouhyoung et al., "Web-enabled Speech Driven Facial Animation", Proc. Of ICAT '99 (int' Conference on Artificial Reality and Tele-existence), pp 23-28, Dec 1999, Tokyo,

Art Unit: 2671

Japan, as applied to claim 1 above, and further in view of Francini et al. U. S. Patent No. 6532011.

Referring to claims 7 and 8, the rationale for claim 1 above is incorporated herein, H. Noot et al., as modified above, teaches a method of creating an animated entity wherein the color of a component is changed (page 29, Figure 11, i.e. change interior color and page 33, Sections SetFillColor and SetPolygonColor) wherein the chosen colors are added to the image file for use in the animated entity but does not specifically teach wherein the method of creating an animated entity further comprises presenting the sender with an option to choose textures for teeth, eyes, and a tongue.

Francini et al. teaches wherein the method of creating an animated entity further comprises presenting the sender with an option to choose textures for teeth, eyes, and a tongue (figure 3) wherein the chosen textures are added to the image file for use in the animated entity (figure 9).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of H. Noot et al. to include presenting the sender with an option to choose textures for teeth, eyes, and a tongue wherein the chosen textures are added to the image file for use in the animated entity because the option of different textures for the teeth, eyes, and tongue allow for humorous as well as realistic characteristics in animated entities.

Referring to claim 14, the rationale for claims 8 and 12 above are incorporated herein, H. Noot et al., as modified above, teaches a method of enabling a sender to create an animated entity for delivering a multi-media message from the sender to a

Art Unit: 2671

recipient, as applied to claim 12 above, and further comprised of presenting the sender with options to modify a texture of teeth, eyes, and/or tongue (H. Noot et al., Section 3.6.6 Operations on components, page 20, figure 4; Section 3.7.3 Basic components, page 26, paragraphs 4, 7, 9, 11, and 14; Figure 11, page 29; and Section 6.5. Editing an animation, page 46 modification of animation after creation implies the ability to modify these textures).

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over H. Noot and Zs.M. Ruttkay, "CharToon 2.0 Manual", Information Systems (INS), INS-R0004 January 31, 2000, Mayle et al. U. S. Patent No. 6018774 and Sato et al. U. S. Patent No 5537662 in view of Ming Ouhyoung et al., "Web-enabled Speech Driven Facial Animation", Proc. Of ICAT '99 (int' Conference on Artificial Reality and Tele-existence), pp 23-28, Dec 1999, Tokyo, Japan, as applied to claim 1 above, and further in view of Shaw et al. U. S. Patent No. 6147692.

Referring to claim 9, the rationale for claim 1 above is incorporated herein, H. Noot et al., as modified above, teaches a method of creating an animated entity, as described above, but does not teach wherein the method of creating an animated entity further comprises presenting the sender with an option to choose different teeth from a group of teeth for the animated entity.

Shaw et al. teaches morphing a human face with an animal face (figures 10(A & B), 14(A-D)) wherein the shape of the teeth are morphed as well (Figures 1, 4, and 12-14, i.e. it is understood that making the mouth area larger or smaller would require

making the teeth smaller or larger to fit the new mouth shape) but does not specifically teach choosing different teeth from a group of teeth. It would have been obvious to one having ordinary skill in the art at the time the invention was made that realistic morphing of animal and human facial features include realistic morphing of animal and human teeth be included in order to provide animal type teeth for realistic morphing of animal and human facial features.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of creating an animated entity to include presenting the sender with an the option of choosing different types of teeth from a group of teeth allowing for humorous as well as realistic characteristics in animated entities as well as extend the limited scope of animation techniques to include creating moving morphs, where characters can speak, move, and emote during the morphing process and to include parametric character creation, where features can be sequentially added to a character the create a wide variety of resulting characters (Shaw et al.; Abstract).

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over H. Noot and Zs.M. Ruttkay, "CharToon 2.0 Manual", Information Systems (INS), INS-R0004 January 31, 2000, Mayle et al. U. S. Patent No. 6018774 and Sato et al. U. S. Patent No 5537662 in view of Ming Ouhyoung et al., "Web-enabled Speech Driven Facial Animation", Proc. Of ICAT '99 (int' Conference on Artificial Reality and Tele-existence),

pp 23-28, Dec 1999, Tokyo, Japan, as applied to claim 1 above, and further in view of Burson et al. U. S. Patent No. 4276570.

Referring to claim 10, the rationale for claim 1 above is incorporated herein, Sato et al., as modified above, teaches a method of creating an animated entity, as described above, but does not teach wherein the method of creating an animated entity further comprises presenting the sender with an option to choose aging effects associated with the animated entity and using the aging effect to modify the image file to increase or decrease the appearance of the age of the image file according to the option chosen by the sender.

Burson et al. teaches wherein the method of creating an animated entity further comprises presenting the sender with an option to choose aging effects associated with the animated entity and using the aging effect to modify the image file to increase or decrease the appearance of the age of the image file according to the option chosen by the sender (column 3-4, lines 66-9; column 6, lines 17-28).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method to include wherein the method of creating an animated entity further comprises presenting the sender with an option to choose aging effects associated with the animated entity and using the aging effect to modify the image file to increase or decrease the appearance of the age of the image file according to the option chosen by the sender because an option to choose aging effects associated with the animated entity and using the aging effect to modify the image file to increase or decrease the appearance of the age of the image file according

to the option chosen by the sender thereby simulating the realistic appearance of different ages in an animated entity.

Claims 11 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over over H. Noot and Zs.M. Ruttkay, "CharToon 2.0 Manual", Information Systems (INS), INS-R0004 January 31, 2000 and Mayle et al. U. S. Patent No. 6018774 in view of Ming Ouhyoung et al., "Web-enabled Speech Driven Facial Animation", Proc. Of ICAT '99 (int' Conference on Artificial Reality and Tele-existence), pp 23-28, Dec 1999, Tokyo, Japan in view of Francini et al. U. S. Patent No. 6532011 as applied to claims 1 and 12 above, and further in view of Murata U. S. Patent No. 5638502.

Referring to claims 11 and 15, the rationale for claims 1 and 12 above are incorporated respectively herein, H. Noot et al., as modified above, teaches a method of creating an animated entity, as described above, but does not teach wherein the method of creating an animated entity further comprises presenting the sender with an option to modify the appearance of weight of the animated entity and modifying the image file to increase or decrease the appearance of weight of the animated entity according to the option chosen by the sender.

Murata teaches wherein the method of creating an animated entity further comprises presenting the sender with an option to modify the appearance of weight of the animated entity and modifying the image file to increase or decrease the appearance of weight of the animated entity according to the option chosen by the sender (figures 17, 20, 24(elements SK8-10), 26(A-C), 27(A & B); column 19, lines 51).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method to include wherein the method of creating an animated entity further comprises presenting the sender with an option to modify the appearance of weight of the animated entity and, using the chosen weight by the sender, modifying the image file to increase or decrease the appearance of weight of the animated entity according to the option chosen by the sender because presenting the sender with an option to modify the appearance of weight of the animated entity and, using the chosen weight by the sender, modifying the image file to increase or decrease the appearance of weight of the animated entity according to the option chosen by the sender allowing for the realistic appearance of different body types in an animated entity.

Response to Arguments

Applicant's arguments filed 5/24/2005 have been fully considered but they are not persuasive.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Regarding amended claim 20-24 and 27-28, Applicant first argues that Noot fails to disclose or suggest that the image received from the sender is received over the

Art Unit: 2671

Internet and further that Noot also fails to disclose that the image received from the sender is received over a network. Examiner respectfully submits that Noot does disclose a network of computers, connected by communications facilities, see rationale for claim 20 above. Applicant then argues, with regards to Mayle, that "Mayle is completely devoid of disclosing an animated entity. Assuming *arguendo* that Mayle discloses receiving from a sender, via a network, an image of an entity, Mayle does not disclose or suggest that the entity is animated. Further, Mayle does not disclose modifying facial features of an entity. Therefore, Mayle has no need for additional information regarding the facial features of an entity in an image and does not disclose or suggest requesting the sender, via the network, to mark facial features on the entity and receiving the facial features marked by the sender". Examiner respectfully submits that both Noot and Mayle disclose wherein the animation/image files are saved as .gif files (see Noot page 22, 2nd paragraph, page 32, LoadImage paragraph, and page 35, Section 4.1 Using Face Player, last paragraph; and Mayle column 7, lines 15-20) and further submits that Noot is relied on for these limitations, see rationale for claim 20 above.

Regarding amended claims 1, 2, 4-6, 12, and 13, Applicant argues that Mayle fails to disclose wherein the category information relates to whether the animated entity will be generally available or only available to the sender and that Mayle appears to disclose wherein "Either the data is available or it is not available based on a length of time the data has been stored or the number of times it has been viewed. Further, Mayle, at col. 5. lines 44-51, discloses that a card key is created when the card is sent

and that the card key is required to retrieve the card data. Thus, when the data is available, it is only available to those who have been given the key.” Examiner respectfully submits that the sender has the option of providing (i.e. make generally available) or not providing (i.e. only available to the sender) the card key and that Mayle further discloses that while there is an option to limit the availability to a specified number of days there is also an option to retain the data for additional uses, see column 5, lines 63-65.

Regarding claim 3, Applicant argues that the amendments to claim 1 obviate the rejection. Examiner respectfully requests that Applicant look to Examiner’s answer to the arguments regarding claim 1 above.

Regarding claims 7, 8, and 14, Applicant next argues that “...Francini, at col. 7, lines 59-60 discloses that “teeth have a standard texture, defined in advance.” Therefore, Francini does not disclose or suggest presenting the sender with an option to choose a texture for teeth, as required by claims 7 and 8...”. Examiner respectfully submits that claims 7 and 8 do not disclose a limitation of providing more than one texture choice for teeth from which to choose. Claims 7 and 8 disclose the limitation of choosing plural textures for plural components, i.e. one texture for teeth, one texture for eyes, and one texture for tongue add up to three textures in total.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was

within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Regarding claim 9, Applicant argues that neither Shaw nor any of Noot, Mayle, and Ouhyoung disclose or suggest presenting the sender with an option to choose different teeth from a group of teeth for the animated entity. Examiner respectfully argues that as H. Noot et al. discloses the option of choosing facial features (such as eyes or mouths) from groups of facial features (such as a group of eyes or a group of mouths) and as Shaw et al. discloses combining a human face with an animal face to create a new creature, then it would have been obvious to include presenting the sender with an the option of choosing different types of teeth from a group of teeth allowing for realistic teeth characteristics to be modeled in the new creature thus created in the invention of H. Noot et al., see rationale for claim 9 above.

Applicant then argues that the Examiner failed to make a prima facie case of obviousness. Examiner respectfully submits that Applicant should look to the Abstract of Shaw et al. for the suggestion or motivation to combine H. Noot et al. with Shaw et al., see rationale for claim 9 above.

Regarding claim 10, Applicant submits that amended claim 1 obviates the rejection of claim 10. Examiner respectfully requests that Applicant look to Examiner's answer to the arguments regarding claim 1 above.


Art Unit: 2671

Regarding claim 10, Applicant submits that amended claims 1 and 12 obviate the rejection of claims 11 and 15. Examiner respectfully requests that Applicant look to Examiner's answer to the arguments regarding claims 1 and 12 above.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


ULKA J. CHAUHAN
PRIMARY EXAMINER

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roberta Prendergast whose telephone number is (571) 272-7647. The examiner can normally be reached on M-F 7:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ulka Chauhan can be reached on (571) 272-7782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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